

REMARKS

Claims 11 remains pending, and presently stands rejected under 35 U.S.C. 101 as claiming the same subject matter as that of claims 1, 3 and 6-9 of prior U.S. Patent No. 5,926,787 and also claims 1, 4, 12 and 15 of U.S. Patent No. 5,815,639. Claim 11 also stands rejected under 35 U.S.C. 103(a) as being unpatentable over Lefler (4,724,285) in view of Yoshida (4,412,305). Applicant respectfully traverses these rejections.

With regard to the Section 101 rejection, Applicant submits that claim 11 of the present application does not include at least the following limitations found in the claims from the '787 and '639 patents referenced by the Examiner in the rejection:

- "said processing system identifying substitute text for those of the words spoken that the processing system fails to identify exact textual representations" ('787 patent, claims 1 and 3)

- "said processing system directing display of the exact textual representations and the substitute text on the screen" ('787 patent, claims 1 and 3)

- "said processing system identifying third textual representations for spoken words in real-time for those of the words spoken that the processing fails to identify the second textual representations, said third textual representations being different that the first textual representations corresponding thereto" ('787 patent, claims 6-9)

- "a second screen that displays at least the second and third textual representations" ('787 patent, claims 6-9)

- "a phoneme library for storing associations between coded representations of spoken words in the first phoneme format and pronounceable but not exact representations of spoken words in a second phoneme format" ('639 patent claims 1 and 4)

- "said transcriber retrieving from said phoneme library coded representations of spoken words in the second phoneme format that are pronounceable by a lay person using coded representations of spoken words in the first phoneme format for which said cross-reference library stores no associations" ('639 patent claims 1 and 4)

- “communication means for delivering both the exact alphabetic and numeric text and the coded representations of spoken words in the second phoneme format to the viewing terminal for display” (‘639 patent claims 1 and 4)

- “substitution means, utilized whenever said cross-reference means fail to identify exact alphabetic and numeric text, for identifying pronounceable substitute text from the coded representations generated by said input means that, when pronounced by a lay person, sounds like the spoken words” (‘639 patent claims 12 and 14)

- “communication means for delivering the exact text from said cross-reference means and the substitute text from said substitution means to the viewing terminal for display” (‘639 patent claims 12 and 14)

It should be clear from these limitations alone not found in claim 11 of the present application, that the claims of the ‘787 and ‘639 patent are *not* claiming the same invention as claim 11 of the present application, and therefore a 35 U.S.C. 101 same invention double patenting rejection in the present application is not proper. Accordingly, Applicant believes the double patenting rejection has been overcome.

With regard to the 35 U.S.C. 103(a) rejection of Lefler (4,724,285) in view of Yoshida (4,412,305), Applicant submits that the combination does not disclose or suggest at least “translating, in real-time, the text in the first language to text in a second language” and “communicating the text in the second language to a terminal for real-time display.”

Specifically, while the Examiner states that the “translating” clause is suggested by Lefler, Applicant was unable to find any discussion whatsoever in the Lefler reference that mentions translation of text in a first language to text in a second language, or to do so in real-time (e.g., as the words in the first language are being spoken).

It appears, therefore, that the Examiner is relying on the Yoshida reference for language translation. However, the Yoshida reference does not discuss in any way the translation of text from a first language to text in a second language, in real-time as the words are being spoken in the first language during a testimonial proceeding, as claimed by Applicant. Instead, the

Yoshida reference is directed to an electronic translator device used by travelers, for example, which stores pre-defined sentences or phrases in two languages. With reference to the example discussed in detail at column 4, line 59 to column 6, line 24 of the Yoshida reference, the Yoshida device requires the user to (1) know ahead of time a desired sentence or phrase to be translated, (2) identify a key-word that can be used to search for the desired sentence or phrase to be translated, (3) perform the key-word search to locate the desired sentence or phrase to be translated, (4) view the display to determine whether the proper sentence or phrase to be translated has been identified by the translator in response to the key-word search, (5) select a continuation function if the identified word or phrase does not correspond to the desired word or phrase to be translated, so that another search can be performed, (6) select the identified word or phrase if it corresponds to the desired word or phrase to be translated, and (7) view the display to see the word or phrase in the other language that corresponds to the desired word or phrase.

Clearly, the user input intensive operations of the Yoshida device renders the Yoshida reference not suitable for real-time translation of text from a first language to text in a second language, as the words are being spoken in the first language during a testimonial proceeding (where multiple speakers are speaking, often at once), as claimed by Applicant. Applicant submits that the Yoshida reference teaches away from the combination of Lefler and Yoshida -- there is no discussion or suggestion as to how the output of the Lefler device could be used as the input of Yoshida, particularly since Yoshida requires user input, response and selection, to achieve language translation. The combination would in the very least require a modification of the fundamental operation of the Yoshida device and additional communication overhead between the Lefler and Yoshida devices that is simply not disclosed or suggested in the cited references. In fact, Applicant submits that the combination of Lefler and Yoshida would simply be inoperable for the purpose attributed to the combination by the Examiner (i.e., to achieve the claimed invention).

Moreover, with regard to the "communicating" clause, even if the language translation is performed by the Yoshida reference, there is no suggestion in Yoshida to communicate the text

in the second language to a terminal for real-time display. Yoshida only refers to its own display, and not to communicating to another terminal for real-time display. In fact, there is no communication interface whatsoever disclosed in Yoshida that would enable this claim limitation. Again, the Yoshida device would need to be modified in an even further way not disclosed or suggested in the cited references.

Based on the foregoing, Applicant believes the 35 U.S.C. 103(a) rejection of Lefler (4,724,285) in view of Yoshida (4,412,305) has been overcome.

With regard to paragraph 2 of the Office Action, it was Applicant's understanding that for a continuation application, the MPEP 609(I)(A)(2) requires that an Examiner re-consider in the continuation application, art considered in a parent application or applications. Because this case is a continuation application, Applicant submitted copies of the PTO-Forms 892 from the parent cases for the convenience of the Examiner, to indicate to the Examiner what references were in fact considered in those cases. Based on the Examiner's statement, however, Applicant is submitting herewith as an IDS, a PTO Form 1449 listing the references that are found on the copies of PTO Forms 892 submitted previously by Applicant. Applicant encloses a check that includes the \$180.00 fee amount pursuant to 37 C.F.R. 1.17(p) for this IDS submission.

With regard to paragraph 3 of the Office Action, the present application is a continuation of the incorporated patents, and has the identical disclosure to those patents. Thus, there is no essential material in those patents that is not already specifically recited in the present application. Accordingly, Applicant respectfully submits that the incorporation of those patents is not improper.

With regard to paragraph 4, of the Office Action, Applicant has cancelled the text in the existing Abstract, and is submitting substitute text therefore. Applicant respectfully submits that the objection to the Abstract has been overcome.

Finally, Applicant is submitting herewith a Request for a Three-Month Extension of Time to respond to the December 18, 2002 Office Action, as well as a check including the amount of \$930.00 to cover the associated fee.

Applicant believes claim 11 is in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, Applicant respectfully requests that the Examiner telephone the undersigned at (312) 775-8108.

A Notice of Allowability is courteously solicited. Please direct all telephone inquiries to the undersigned at (312) 775-8108.

Respectfully submitted,



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